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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,754	09/18/2001	Charles J. Rice	4810-002	8506

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EXAMINER

WINDMULLER, JOHN

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 08/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/954,754		RICE, CHARLES J.	
	<b>Examiner</b>		<b>Art Unit</b>	
	John Windmuller		3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                 | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to because of the following informalities: On page 2, line 3, the term "is" should be removed.

Appropriate correction is required.

### ***Claim Objections***

2. Claim 15 is objected to because of the following informalities: Line 6, the term --a-- should be inserted between adjacent terms "in" and "first". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14, 25, 26, 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples of vague and indefinite language which render the claims indefinite.

Claim 1, line 6, "a first direction". Lines 8-9, "a second direction". Do these terms refer to the same first and second directions claimed on line 5 of the claim? If so, they should be preceded by the article "the" or "said" to indicate antecedent basis.

Claim 12, line 2, "a first phase", line 3, "a first direction", line 4, "a second phase", line 5, "a second direction". Do these terms refer to the same first and second directions and phases of claim 1? If so, they should be preceded by the articles "the" or "said" to indicate antecedent basis.

Claim 29, line 2, "first direction", "a first phase", "a tool cycle"; line 3, "a first side"; line 4, "second direction", "a second phase", "a tool cycle"; lines 4-5, "a second side". Do these terms refer to the same items that similar terms of claim 15 refer to? If so, they should be preceded by the articles "the" or "said" to indicate antecedent basis.

The following are examples of terms which lack sufficient antecedent basis in the claims. Claim 7, lines 2-3, "the end of the workpiece". Claim 13, lines 1-2, "the carrier block". Claim 25, line 2, "the first and second cams". Claim 26, line 2, "the first cam", line 4, "the second cam".

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8, 10, 13-22, 24, 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Koster. The device of Koster teaches the invention as claimed, including, inter alia:

Regarding claims 1, 15, 29, 30, a workpiece holder (Fig. 2, 19, 23), a tool (Fig. 11, 34) insertable into an end of the tubular workpiece (col. 3, lines 25-26), tool holder movable in first and second directions (Fig. 5, 31), a first cam to drive the tool holder in a first direction during a first phase of a tool cycle to engage the tool with a first side of the workpiece (col. 2, lines 2-10; col. 3, lines 22-39), a second cam driven synchronously with the first cam to drive the tool holder in a second direction during a second phase of a tool cycle to engage the tool with a second side of the workpiece (col. 2, lines 2-10; col. 3, lines 22-39; col. 1, lines 60-78).

Regarding claims 2, 16, the workpiece holder comprises a die block having an opening therein to receive the workpiece (Fig. 2, 19, 23).

Regarding claims 3-5, 17-19, an interchangeable die insertable into the opening in the die block (Fig. 2, 19, 23) comprising a sleeve that surrounds the workpiece and a cutting edge that cooperates with the tool to shear the workpiece.

Regarding claims 6, 7, 20, 21, the tool comprises a shear, shaped to notch the end of the workpiece (Figs. 10, 11).

Regarding claims 8, 22, the tool comprises a piercing tool to form an opening in the workpiece (Figs. 10, 11). The tool as shown can be considered a piercing tool.

Regarding claims 10, 24, the tool holder comprises a reciprocating carrier block having an opening therein to receive the tool (Fig. 5, 31, 33).

Regarding claims 13, 14, 27, 28, biasing means comprising at least one spring to bias the carrier block to a neutral position (Fig. 2, 50).

Regarding claim 31, the tool is idle during a third phase of the tool cycle (col. 3, lines 46-49).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koster as applied to claims 1 and 15 above in view of Belzil. The device of Koster discloses the invention as claimed except a plurality of interchangeable tools. However, Belzil teaches a plurality of interchangeable tools (Figs. 6, 9, 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Koster with a plurality of interchangeable tools as taught by Belzil for greater versatility in cutting the pipe.

***Allowable Subject Matter***

9. Claims 11, 12, 25, 26, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. While certain prior art does show a carrier block with cam openings (Terasaka, Figs. 7, 8, items 72, 74, unlabeled space housing 72 in Fig. 8; Sitte, Figs. 1, 1a, 1b, items 13, 10, 11, 12), the prior art is

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not combinable with Koster and furthermore there is no motivation to combine any of the prior art with Koster.


### ***Conclusion***


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Coulon (interior pipe cutting, Figs. 1, 4, 6), Criblez (dual cam, Fig. 1), Vernacchio (interior pipe cutting, Figs. 3, 4, claim 3), Cullinan et al. (interior pipe piercing, Figs. 3, 4), Sitte (opening for cam, Figs 1, 1a, 1b), Terasaka (opening for cam, Figs. 7, 8, items 72, 74), Benkert et al. (interior pipe piercing, the Figure), Woodburn (interior pipe punching, cam, Figs. 2, 5).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Windmuller whose telephone number is 703 30-4988. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703 308-1082. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-1148.

jw   
August 15, 2003

  
Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700